

ESTTA Tracking number: **ESTTA128480**Filing date: **03/07/2007**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91175356
Party	Defendant BIODROGA COSMETIC GMBH BIODROGA COSMETIC GMBH Im Rosengarten, 76532 BADEN-BADEN , DE
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Date	03/07/2007
Attachments	91175356_20070307124243.pdf ( 8 pages )(230792 bytes )

## Registrations Subject to Cancellation

Registration No	2577799	Registration date	06/11/2002
Registrant	La Prairie, Inc. 680 Fifth Avenue New York, NY 10019 UNITED STATES		
Goods/Services Subject to Cancellation	Class 003. First Use: 1989/00/00 , First Use In Commerce: 1989/00/00 Goods/Services: skin care products, namely, gel that firms and tones the skin in the eye area		
Registration No	2577800	Registration date	06/11/2002
Registrant	La Prairie, Inc. 680 Fifth Avenue New York, NY 10019 UNITED STATES		
Goods/Services Subject to Cancellation	Class 003. First Use: 1990/00/00 , First Use In Commerce: 1990/00/00 Goods/Services: skin care products, namely, gels that firm and tone the skin		
Registration No	2577801	Registration date	06/11/2002
Registrant	La Prairie, Inc. 680 Fifth Avenue New York, NY 10019 UNITED STATES		
Goods/Services Subject to Cancellation	Class 003. First Use: 1987/00/00 , First Use In Commerce: 1987/00/00 Goods/Services: skin care products, namely, gels that firm and tone the skin		

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

La Prairie, Inc.

Opposer,

v.

BIODROGA COSMETIC GMBH

Applicant.

Opposition No. 91/175,356  
Serial No. 79/012085

**ANSWER TO NOTICE OF OPPOSITION**

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Applicant BIODROGA COSMETIC GMBH hereby answers the Notice of Opposition as follows:

1. Admitted.
2. Applicant is without knowledge or information sufficient to form a belief as to the averments of paragraph 2, and therefore denies the same.
3. Applicant is without knowledge or information sufficient to form a belief as to the averments of paragraph 3, and therefore denies the same.
4. Applicant is without knowledge or information sufficient to form a belief as to the averments of paragraph 4, and therefore denies the same.
5. Applicant is without knowledge or information sufficient to form a belief as to the averments of paragraph 5, and therefore denies the same.

6. Applicant admits that the trademark records say what they say, but otherwise denies all other averments of paragraph 6.

7. Applicant acknowledges the *prima facie* rights established by a federal registration, but such rights can be rebutted and, therefore Applicant denies all other averments of paragraph 7.

8. Applicant acknowledges that Opposer's registration predates Applicant's application for its mark which is irrelevant where confusion is not likely and Opposer's mark is generic. Applicant is without knowledge or information sufficient to form a belief as to all other averments of paragraph 8, and therefore denies the same.

9. Applicant is without knowledge or information sufficient to form a belief as to the averments of paragraph 9, and therefore denies the same.

10. To the extent that Opposer avers its SKIN CAVIAR trademark is a strong and famous trademark, Applicant denies the averments of paragraph 10. Applicant is without knowledge or information sufficient to form a belief as to the remainder of the averments of paragraph 10, and therefore denies the same.

11. Applicant is without knowledge or information sufficient to form a belief as to the averments of paragraph 11, and therefore denies the same.

12. Denied.

13. Denied.

14. Denied.

15. Applicant admits that the registration of Applicant's mark would provide, at least, the *prima facie* exclusive right to the Applicant's mark on the relevant goods (subject to the

disclaimer of any exclusive right to use “caviar” apart from the mark as a whole). Applicant denies all other averments of paragraph 15.

16. Applicant is without knowledge or information sufficient to form a belief as to the remainder of the averments of paragraph 16, and therefore denies the same.

### **AFFIRMATIVE DEFENSES**

1. Opposer’s marks are generic.
2. Opposer’s marks are merely descriptive.
3. Opposer’s marks are incapable of acquiring distinctiveness.
4. Opposer’s prayer for relief is barred by the doctrines of waiver and estoppel.
5. Applicant reserves the right to assert any additional defenses which it may learn through discovery.

WHEREFORE, Applicant prays that the Opposition be denied.

### **COUNTERCLAIMS**

#### **Consolidated Petitions to Cancel**

Applicant believes it is now and will in the future continue to be damaged by Opposer’s registrations of the trademarks SKIN CAVIAR as shown in Registration No. 2577801, EXTRAIT OF SKIN CAVIAR as shown in Registration No. 2577800, and ESSENCE OF SKIN CAVIAR as shown in Registration Number 2577799, all of which registered on June 11, 2002 (hereinafter the “Registered Marks”), and hereby petitions to cancel said registrations.

The grounds for this petition are as follows:

1. Opposer is the owner of U.S. Registration No. 2577801 of the mark SKIN CAVIAR for skin care products, namely, gels that firm and tone the skin.

2. Opposer is the owner of U.S. Registration No. 2577800 of the mark EXTRACT OF SKIN CAVIAR for skin care products, namely, gels that firm and tone the skin.

3. Opposer is the owner of U.S. Registration No. 2577800 of the mark ESSENCE OF SKIN CAVIAR for skin care products, namely, gels that firm and tone the skin in the eye area.

4. The Registered Marks issued less than 5 years from the filing date of this Petition.

5. Skin care products are commonly used on and in connection with skin.

6. Upon information and belief, Opposer's skin care products are for used in upon and in connection with the skin.

7. Upon information and belief, Opposer's skin care products are designed to firm and tone the skin.

8. Opposer's competitors use the word "skin" to describe skin care products that firm and tone the skin.

9. Consumers of Opposer's products are aware that Opposer's products are for the skin.

10. The term "skin" is descriptive of skin care products, namely, gels that firm and tone the skin, within the meaning of Section 2(e) of the Lanham Act.

11. The term "skin" is incapable of acquiring distinctiveness in connection with skin care products, namely, gels that firm and tone the skin.

12. The term “skin” is generic for skin care products, namely, gels that firm and tone the skin.
13. Upon information and belief, Opposer’s skin care products contain caviar.
14. Upon information and belief, an active ingredient in Opposer’s skin care products is caviar.
15. Upon information and belief, Opposer’s skin care products main ingredient is caviar.
16. Caviar, as used in skin care products, is an effective ingredient for nourishing, protecting, and rejuvenating the skin.
17. Caviar has a desired effect when used in connection with and upon the skin.
18. Consumers of Opposer’s product desire Opposer’s product because it contains caviar.
19. Consumers of Opposer’s products are aware that Opposer’s products contain caviar.
20. Caviar is commonly used as an ingredient in skin care products.
21. Opposer’s competitors use the word “caviar” to describe skin care products that contain caviar.
22. The term “caviar” is descriptive of skin care products that contain caviar, within the meaning of Section 2(e) of the Lanham Act.
23. The term “caviar” is incapable of acquiring distinctiveness in connection with skin care products that contain caviar.

24. The term “caviar” is generic for skin care products that contain caviar.

25. Opposer has attempted to assert exclusive rights in the words “skin caviar” for skin care products containing caviar.

26. Opposer has attempted to assert exclusive rights in the words “extrait of skin caviar ” for skin care products which contain extract of caviar

27. Opposer has attempted to assert exclusive rights in the words “essence of skin caviar ” for skin care products which contain essence of caviar.

28. Continued registration of the Registered Marks by Opposer would provide Opposer with a basis to object to the use of the words “skin caviar” “extrait of skin caviar,” and “essence of skin caviar” in connection with skin products that contain caviar and would harm Applicant by interfering with Applicant’s right to use the word “caviar” in connection with its goods and to secure registration of the mark GOLDEN CAVIAR OF BIODROGA.

29. Continued registration of the Registered Marks by Opposer would provide Opposer with a basis to object to the use of “caviar” in connection with skin products that contain caviar and related goods, and would harm the public by interfering with competitors’ right to use the words “skin” and “caviar” in connection with competing skin care products that contain caviar.

WHEREFORE, BIODROGA COSMETIC GMBH believes that it is and will continue to be damaged by the registration of SKIN CAVIAR, EXTRAIT OF SKIN CAVIAR, and ESSENCE OF SKIN CAVIAR on the Principal Register by Opposer, and prays that said

registrations be cancelled. Please charge the filing fee to Deposit Account 100435 (Our Reference No. 22386-201790).

Date: March 7, 2007

Respectfully submitted,

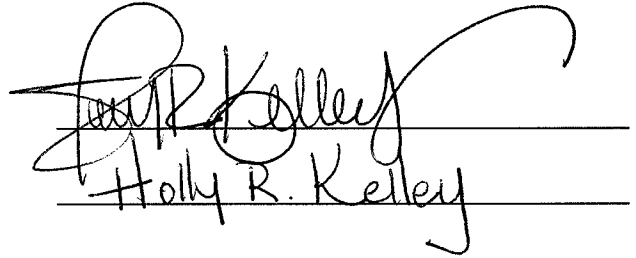
**BIODROGA COSMETIC GMBH**

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the Answer to Notice of Opposition has been served March 7, 2007, by depositing a copy of the same in the United States mail, first class postage prepaid and properly addressed to the following counsel of record:

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Holly R. Kelley